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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN C. GOODWIN, III and JOHN BRIAN FRANCIS

Appeal 2009-0786
Application 09/727,290
Technology Center 2600

Decided:¹ February 10, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and CARLA M.
KRIVAK, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b). We reverse. We, however, enter a new ground of rejection under 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants invented a method and kiosk for displaying information. Using a proximity sensor, the method and kiosk sense a person passing within a given distance of the kiosk. If sensed, specific programming commences. If the sensed person does not use the kiosk within a time period or is no longer within a given distance of the kiosk, different programming is displayed.² Claim 1 reads as follows:

1. A method of displaying information by a network kiosk comprising the steps of:

sensing a person passing within a predetermined distance of the kiosk by a proximity sensor of the kiosk;

displaying first information in response to said sensing step by a display of the kiosk to attract attention of the person to the first information of the display and to attempt to persuade the person to approach and use the kiosk;

timing a time period of displaying the first information;
and

displaying second information which is less distinctive than the first information by the display if the person does not begin use of the kiosk within the time period.

² See generally Spec. 3:11-27, 4:27-5:2, and 6:13-7:21.

The Examiner relies upon the following as evidence in support of the rejection:

Cragun	US 5,504,675	Apr. 2, 1996
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(1) Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cragun (Ans. 3-7).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer³ for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner finds Cragun discloses all the elements in claim 1 (Ans. 3). Appellants argue Cragun does not disclose the claimed steps of: (1) displaying first information in response to the sensing step, (2) timing a time period of displaying the first information, and (3) displaying less distinctive second information if the person does not begin to use the kiosk within the time period (Br. 7-9).

ISSUE

Have Appellants shown the Examiner erred in finding that Cragun discloses the steps of displaying first information in response to the sensing step and timing a time period of displaying the first information in rejecting claim 1 under § 102?

³ Throughout this opinion, we refer to (1) the Appeal Brief filed September 6, 2006, and (2) the most recent Examiner's Answer mailed September 17, 2007.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Cragun discloses step 102 of sensing a person passing within a given distance of a kiosk 10 using sensor 20 (Cragun, col. 4, ll. 24-26; col. 5, ll. 11-14 and 26-31; Figs. 1 and 4).
2. When the sensor fails to sense a person within the immediate area of kiosk 10, the “attract” program is played at step 104 (Cragun, col. 5, ll. 14-20; Fig. 4).
3. If the person is sensed within the immediate area of kiosk 10 and the touch screen 16 has not been touched, the kiosk displays the best specific loop program. This program is intended to make passers-by respond by moving closer to the display and interacting with the touch screen (Cragun, col. 2, ll. 15-18, col. 4, ll. 11 and 12; col. 5, ll. 26-36; col. 7, ll. 45-51; Figs. 1 and 4).
4. Cragun discloses sensing at step 116 if someone is within a given distance of kiosk 10 and, if so (“T” branch of step 116), determining whether the touch screen 16 was touched at step 112 (Cragun, col. 5, ll. 37-41 and 43-49; Figs. 1 and 4).
5. At step 112, the program detects whether the screen was touched “within a predetermined short time interval.” If so (“T” branch of step 112), Cragun also determines at step 118 whether this interaction was within the preceding sixty seconds (Cragun, col. 5, ll. 47-57).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros, Inc. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987). “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).

An open-ended transitional phrase, such as “comprising,” does not exclude additional and unrecited method steps. *Mars, Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376 (Fed. Cir. 2004).

ANALYSIS

Using sensor 20, Cragun discloses sensing (step 102) a person passing within a given or predetermined distance of kiosk 10 (FF 1). Step 104 fails to display information in response to sensing a person within a predetermined distance (FF 2). However, Cragun discloses displaying the best loop program or “first information” (step 114) when someone is present (“T” at step 102) and the touch screen 16 has not been touched (“F” at step 112) (FF 3). As claim 1 recites an open-ended transitional phrase, “comprising,” the claim does not preclude intermediary steps occurring between sensing a person and displaying the first information. *See Mars*, 377 F.3d at 1376. Thus, even though Cragun shows the step of determining whether the touch screen has been touched (step 112) occurs immediately prior to displaying the first information at 114, Cragun still discloses displaying “first information” (step 114) in response to sensing a person

within a predetermined distance of kiosk 10 (FF 3). Additionally, the displaying step attempts to attract the passer-by's or person's attention to the information and to persuade the person to approach and use the kiosk (*id.*) as recited in claim 1.

If someone is within a given distance of kiosk 10 ("T" at step 116) after displaying (step 114) has begun, Cragun next determines whether touch screen 16 was touched at step 112 (FF 4). At step 112, Cragun's program detects whether the screen was touched within a predetermined time interval (FF 5), and, if so, whether this interaction was within the preceding sixty seconds at step 118. (*Id.*) The determinations of steps 112 and 118 both involve a time period. Cragun, however, fails to disclose that steps 112 or 118 are performed *while* the program at step 114 is displayed or played. For example, the displaying step at 114 may run in its entirety and then display other information prior to determining whether screen 16 was touched at step 112. Thus, we can only find a high probability or possibility that steps 112 and 114 in Cragun overlap in time. Consequently, Cragun does not necessarily measure or time a time period of displaying the first information as recited in claim 1. *See Robertson*, 169 F.3d at 745. We are, therefore, constrained to find that Cragun does not disclose all the limitations in claim 1.

Similar to independent claim 1, independent claims 2 through 4 and 8 recite methods including the step of "timing a time period of displaying" the first or second information. We are, therefore, persuaded by Appellants' argument regarding claims 2 through 4 and 8 (Br. 7-12) for the same reasons articulated in connection with claim 1.

Independent claims 5 and 6 recite a network kiosk having a display, a proximity sensor, and a computer which displays first information in response to sensing a person and which times a time period of displaying the first information. Similar to the above-discussed analysis of claim 1, Cragun does not necessarily disclose a computer or processor that displays the first information and times the time period of displaying the first information because we cannot find these operations necessarily overlap. For this reason, we are constrained to find that Cragun does not necessarily disclose a computer which times a time period of displaying the first information as recited in claims 5 and 6.

For the foregoing reasons, Appellants have shown error in the Examiner's anticipation rejection of independent claims 1-6 and 8 based on Cragun. We reach the same conclusion with respect to dependent claim 7. We, therefore, will not sustain the anticipation rejection of claims 1 through 8 based on Cragun.

New Ground of Rejection Under 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 103 for claims 1, 2, 5, 6 and 7. Claims 1, 2, 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being obvious over Cragun.

Claim 1

As discussed above in connection with claim 1 and the anticipation rejection, Cragun discloses sensing a person passing within a predetermined distance of kiosk 10 using proximity sensor 20 of the kiosk (FF 1). Additionally, as explained above, Cragun displays a best pitch or first

information in response to the sensing step to attract the person and attempt to persuade the person to approach and use the kiosk (FF 3). Cragun also discloses timing a time period by determining whether the touch screen has been touched within a predetermined period (step 112) some time after displaying the first information (step 114) has commenced (FF 4-5). Cragun, however and as previously stated, falls short of explicitly or inherently disclosing this step of timing a time period includes “timing a time period of displaying the first information” as recited in claim 1.

This limitation, however, does not require timing the *entire* period of displaying the first information. Rather, the breadth of this recitation can read on timing *any* time period, such as the beginning, middle, or end, that the first information is displayed. Thus, so long as Cragun teaches timing some portion of the display of the first information, the prior art teaches this limitation of claim 1.

Cragun discloses monitoring touch-screen display 16 to determine if the screen is touched *during* the attract presentation (step 104) (Cragun, col. 5, ll. 24-31). While this information is not the information displayed when sensor 20 senses a person is within the immediate area or a given distance (step 114), this portion of Cragun still teaches a known technique of gathering touch screen data during a presentation run. Cragun also teaches the sales promotion kiosk is used to provide a user interface that is both entertaining to the user and increases the chances of attracting and holding the attention of a passer-by (Cragun, col. 1, ll. 47-52). Specifically, Cragun collects information regarding whether a person has touched screen 16 during these sessions in order to determine which programs are effective in attracting people and have an effect on sales (Cragun, col. 2, ll. 15-27).

Cragun thus suggests the step of displaying at 114 and the step of determining whether screen 16 was touched at step 112, after the display (step 114) has commenced, should overlap in time in order to collect data that links the person's responses to sales programming. (*Id.*) Based on these teachings, one having ordinary skill in the art would have recognized arranging Cragun's steps 114 and 112 to coincide or partly overlap in time in order to improve the method by collecting more accurate data that relates the time the touch screen 16 is touched to coincide with the programming being viewed and having a more direct association with sales. *KSR*, 127 S. Ct. at 1740. Additionally, each of these steps will still perform the same function and yield no more than an expected or predictable result from such an arrangement. *Id.*

Cragun further teaches touch screen 16 allows the user to respond to inquiries presented by the sales program before moving to the next portion of or a different program because these types of programs are more successful in attracting and holding the attention of the passer-by (Cragun, col. 1, ll. 54-62). Based on this additional teaching, an ordinarily skilled artisan would have recognized maintaining the same programming or information until the user responds would assist in determining the next portion of the program or, if the person fails to respond within a given time period, whether a different program should be shown to attract the user's attention. *KSR*, 127 S. Ct. at 1740. Cragun, thus, teaches the limitation of "timing a time period of displaying the first information" as recited in claim 1.

Lastly, Cragun discloses if the user does not interact with the touch screen within a given time period, such as the predetermined interval or

sixty seconds (FF 4-5), the program will display “second information” (step 104) when the time period has expired (“F” at step 118) and the person is no longer within the predetermined distance of the kiosk (“F” at step 102) (Cragun, col. 5, ll. 15-22 and col. 5, l. 67 – col. 6, l. 4; Fig. 4). Since the limitation, “less distinctive than the first information,” is a relative term, we find that the best attract program at 104 is different from the best pitch program at 114 and is therefore “less distinctive” as broadly recited. Cragun, therefore, discloses the limitation of claim 1 calling for displaying second information.

For the reasons stated above, we find Cragun provides ample teachings to meet all the steps recited in claim 1.

Claim 2

The limitations of claim 2 are nearly identical to claim 1, and we therefore refer to our previous discussion of claim 1. As for the recitation of “displaying second information . . . if the person is no longer within the predetermined distance of the kiosk and the time period has expired,” Cragun discloses the program will display second information (step 104) if the user does not touch the screen and interact with the touch screen within a given time period, such as sixty seconds (“F” at step 118), and no one is near the kiosk (“F” at step 102) (Cragun, col. 5, ll. 15-22 and col. 5, l. 67 – col. 6, l. 4; Fig. 4). Moreover, Cragun determines when a person is not within the predetermined distance of kiosk 10 (“F” at step 102) and displays second information (step 104). Thus, Cragun discloses the “displaying second information” step recited in claim 2.

For the reasons stated above, we find Cragun provides ample teachings to meet all the steps of the method recited in claim 2.

Claim 5

Cragun discloses a network kiosk 10 having a display 16 for displaying information, a proximity sensor 20, and a computer 30 and 40 (Cragun, col. 4, ll. 8-27 and 50-62; Figs. 1-3). Cragun also shows the processor circuit 40 is connected to the synchronous ports 48, which carry the proximity data signals from proximity sensor 20 (Cragun, col. 4, ll. 51-60; Figs. 2 and 3). Cragun discloses the computer 30 is connected to the display 16 and includes a processing circuit 40 that obtains the first or “pitch” program information and second or “attract” program information that is displayed on display 16 (Cragun, col. 5, ll. 1-8, 14-23, and 31-37; Figs. 2-4). Additionally, regarding when and the type of information displayed by the first and second programs, we refer Appellants to the previous discussion of claim 1 in connection with steps 104 and 114. Thus, Cragun discloses a computer that displays first information (step 114) in response to sensing the person and displays second information (step 104) if the person does not begin to use the kiosk within the time period as recited in claim 5.

Cragun also teaches a computer that times a time period of displaying the first information. As explained above in connection with claim 1, Cragun discloses timing a time period at steps 112 and 118. Cragun does not explicitly disclose these steps coincide with the display step at 114. However, as previously discussed with respect to claim 1, Cragun provides reasons to have the steps overlap in order to improve the method by

collecting more accurate information relating to when a person touches a screen during this programming and improving sales (Cragun, col. 1, ll. 54-62 and col. 2, ll. 15-27). Additionally, Cragun teaches allowing the user to respond to inquiries before changing the programming in order to collect response data and more accurately respond to the user. (*Id.*) These teachings, as discussed above, suggest to one having ordinary skill in the art overlapping the touch response step (step 112) with the displaying step (step 114) to improve the accuracy of collecting data and permitting a response prior to changing the programming. *KSR*, 127 S. Ct. at 1740. We also refer back to the discussion of Cragun with respect to claim 1 and its teachings for more details. Cragun, thus, teaches a computer which displays first information as recited in claim 5.

For the reasons stated above, we find Cragun provides ample teachings to meet the network kiosk recited in claim 5.

Claim 6

Claim 6 is similar in scope to claim 5. We thus refer back to the discussion of claim 5 and Cragun for its teachings. With regard to the limitation of “a computer which . . . displays second information . . . if the person is no longer within the predetermined distance of the kiosk and the time period has expired,” we refer to the previous discussion of claim 2 and the “displaying second information” step. Additionally, Cragun discloses the computer (30 and 40) perform this operation (Cragun, col. 4, ll. 51-53 and col. 4, l. 63 – col. 5, l. 8; Figs. 2 and 3).

For the reasons stated above, we find Cragun amply teaches the network kiosk recited in claim 6.

Claim 7

Claim 7 recites the proximity sensor is an ambient light sensor which senses a drop in ambient light when a person is within the predetermined distance. Cragun states proximity sensors can be a microwave sensor or a sensor made by Radio Shack having catalog number 49-550 (Cragun, col. 4, ll. 28-32). The exemplary sensors are not ambient light sensors. However, Cragun suggests that proximity sensors are well known in the art (Cragun, col. 4, ll. 28 and 29). As some proximity sensors are ambient light sensors, one skilled in the art would have thus recognized an ambient light sensor could be used as a proximity sensor for detecting whether a person is near kiosk 10. Using the background knowledge of an ordinarily skilled artisan, we find one skilled in the art would have known to select from any known proximity sensors, including an ambient light sensor, to detect whether a person is within a given distance of kiosk. *See In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006). As *Kahn*, 441 F.3d at 987, also explains the teaching “does not have to be found explicitly in the prior art,” one skilled in the art would have recognized ambient light sensors may be more cost efficient or desirable in a given environment. *See also Dystar Textilfarben GmbH & Co. v. C. H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

For the reasons stated above, we find Cragun provides amply teaches or suggests the ambient light sensor recited in claim 7.

Although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean the remaining claims are patentable over Cragun. Rather, we merely leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

CONCLUSIONS

(1) The Appellants have shown the Examiner erred in finding that Cragun discloses the step of “timing a time period of displaying the” first or second information in rejecting claims 1-4 and 8 under § 102.

(2) The Appellants have shown the Examiner erred in finding that Cragun discloses a computer that “times a time period of displaying the first information” in rejecting claims 5-7 under § 102.

(3) A new ground of rejection under § 103 based on Cragun has been presented for claims 1, 2, 5, 6, and 7.

ORDER

We reverse the Examiner’s rejection of claims 1-8.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) for claims 1, 2, 5, 6, and 7. This section provides that “[a] new ground of rejection... shall not be considered final for judicial review.”

Title 37 of the Code of Federal Regulations, § 41.50(b), also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

ELD

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